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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/566,871	02/02/2006	Hiroshi Mukaihara	45010005211	2222

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EXAMINER	
GIARDINO JR, MARK A	

ART UNIT	PAPER NUMBER
2185	

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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/566,871	MUKAIHARA ET AL.	
	Examiner	Art Unit	
	MARK A. GIARDINO JR	2185	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *10 June 2010*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *9-15* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *9-15* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date *5/13/2010*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 6/10/2010 has been entered.

The instant application having Application No. 10/566,871 has a total of 7 claims pending in the application, there are 3 independent claims and 4 dependent claims, all of which are ready for examination by the examiner.

ACKNOWLEDGEMENT OF REFERENCES CITED BY APPLICANT

Information Disclosure Statement

As required by **M.P.E.P. ' 609 (C)**, the applicant's submission of the Information Disclosure Statement, dated 5/13/2010, is acknowledged by the examiner and the cited references have been considered in the examination of the claims now pending. As required by **M.P.E.P. ' 609 C(2)**, a copy of the PTOL-1449 initialed and dated by the examiner is attached to the instant office action.

REJECTIONS NOT BASED ON PRIOR ART

The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 11 recites the limitation "said interface" in the fourth line of the claim. There is insufficient antecedent basis for this limitation in the claim.

REJECTIONS BASED ON PRIOR ART

Claims 9-11 and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ehara (US 2002/0069237) in view of Boyle (US 2001/0041021), Parulski et al (5,633,678) and Goodman (US 6,704,824).

Regarding Claim 9, Ehara teaches a portable memory device **(memory stick of Figure 4)** comprising:

a terminal capable of being connected to an interface **(the terminal corresponding to the part of the memory stick that "is inserted into a memory slot", Paragraph 0066)** mounted on a host machine **(personal computer of Figure 4)** and capable of data input/output from/to said host machine **(the host computer can automatically read files stored on the memory stick, thus the portable memory device is capable of data input/output from/to said host machine)**,

and a storage element for storing data which include:

at least one of image data and audio data **(image data on the memory stick of Figure 4)**,

reproduction program data for said host machine to reproduce at least one of said image data and audio data **("upload program stored in the memory stick" which reproduces the data onto the personal computer, Paragraph 0078)**, and execution program data for said host machine to execute said reproduction program

using said reproduction program data **(since the operating system activates the upload program, there is inherently execution program data to execute the reproduction program)** and install program data for installing the reproduction program data and the execution program data, wherein, when the host machine does not store the reproduction program data or the execution program data, the install program data automatically installs the reproduction program data and the execution program data **(since the operating system runs the reproduction program on the memory stick, Paragraph 0078, the reproduction and execution program data are not stored on the host machine and instructions for installing the reproduction program and execution data are inherently present in the storage element in order to install and run the program on the host)** in response to connecting the portable memory device to the host machine **(Figure 3 and paragraphs 0073 - 0081)**.

However, Ehara does not explicitly teach a writing program to write at least one of said image data and audio data from said host machine to said storage element in response to a detection signal indicating that said host machine detects a connection of said terminal to said interface.

Boyle teaches a writing program to write at least one of image data and audio data from a host machine to a storage element in response to a detection signal that a host machine detects a connection of said terminal to said interface **(see the description of the write program that uploads data from a personal computer 110 to the handheld electronic device 124, paragraph 0036)**.

It would have been obvious to a person having ordinary skill in the art at the time the invention was made to which the subject matter pertains to have implemented the writing program of Boyle in the device of Ehara in order to transfer images from a host device to a portable memory device, thereby allowing one to easily transfer images to other host devices utilizing the portable memory device.

Further, neither Ehara nor Boyle explicitly teaches storing or installing driver program data on the host machine. Goodman teaches a driver program for operating a portable memory device on the host machine **(step 320 of Figure 3, where the peripheral device [corresponding to a portable memory device] uploads a driver to the host, also Column 2 Lines 30-32 and Column 4 Lines 38-65, and the driver is for operating the host, Column 1 Lines 38-43)**; and

install program data for installing the driver program data **(step 320 of Figure 3, where the driver is installed, thus install program data is inherently present to initiate the installation)**;

wherein the install program data automatically installs the driver program data on the host machine in response to connecting the portable memory to the host machine **(the process in Figure 3 and described on Column 4 Line 15 to Column 5 Line 15 requires no user intervention and begins upon connection of the device [Column 4 Lines 15-16], and the process is referred to as 'automatic' in the abstract, thus the driver program data is automatically installed)**.

It would have been obvious to a person having ordinary skill in the art at the time the invention was made to which the subject matter pertains to have implemented the

automatic driver installation of Goodman in the memory device of Boyle and Ehara because this avoids the need for external media in installing devices (Column 2 Lines 8-18 in Goodman).

Further, the above references do not teach at least one of the image and audio data to be reproduced is selected via the host machine by a user, the selected data being not changed by a user.

Parulski teaches a media device holding pictures, which, when connected to a host computer, a user can select from the host device which categories of pictures the user wishes to transfer from the camera to the host **(left half of Figure 4 and Column 6 Line 60 to Column 7 Line 7)**. It would have been obvious to person having ordinary skill in the art at the time the invention was made to which the subject matter pertains to have allowed a user to select images via the host machine to determine which images are transferred to the host system (as in Parulski) in the device of Boyle, Ehara, and Goodman, since the user may not want all the images on the portable device in the host device.

Regarding Clam 10, Boyle, Goodman, Ehara and Parulski teach a portable memory device as described in Claim 9, wherein the host machine can activate said execution program in response to said detection signal to read and reproduce at least one of said image data and audio data stored in said memory element (Figure 3 of Ehara), when said host machine previously stores at least said reproduction program data and execution program data, and when said terminal is connected to said interface

in the state that said storage element stores at least one of said image data and audio data (S2 of Figure 3).

Regarding Claim 11, Ehara teaches a recording medium for storing a computer-executable program, the program having code comprising:

a detecting step of detecting a detection signal indicating that a terminal of a portable memory device **(memory stick of Figure 4)** is connected to said interface **(Figure 3 and the automatic detection step S1)**;

an executing step of executing a program in a reproduction program data for reproducing at least one of image data and audio data stored in said memory device, in response to said detection signal **(since the operating system activates the upload program, which reproduces data onto the personal computer, Paragraph 0078 there is inherently an executing step to execute the reproduction program)**; and

an installing step of installing the reproduction program data **(since the operating system runs the reproduction program data, Paragraph 0078, there is inherently an installing step to install the reproduction program data onto the host machine)**;

wherein, when the host machine does not store the reproduction program data and the execution program data, the installing step automatically installs the reproduction program data and the execution program data on the host machine **(since the operating system runs the reproduction program on the memory stick, Paragraph 0078, the reproduction and execution program data are not stored on**

the host machine and instructions for installing the reproduction program and execution data are inherently present in the storage element in order to run the program on the host) in response to connecting the portable memory device to the host machine **(Figure 3 and paragraphs 0073 - 0081)**.

However, Ehara does not explicitly teach a writing step to write at least one of said image data and audio data from said host machine to said storage element in response to a detection signal indicating that said host machine detects a connection of said terminal to said interface.

Boyle teaches a writing program to write at least one of image data and audio data from a host machine to a storage element in response to a detection signal that a host machine detects a connection of said terminal to said interface **(see the description of the write program that uploads data from a personal computer 110 to the handheld electronic device 124, paragraph 0036)**.

It would have been obvious to a person having ordinary skill in the art at the time the invention was made to which the subject matter pertains to have implemented the writing step of Boyle in the device of Ehara in order to transfer images from a host device to a portable memory device, thereby allowing one to easily transfer images to other host devices utilizing the portable memory device.

Further, neither Ehara nor Boyle explicitly teaches storing or installing driver program data on the host machine. Goodman teaches a driver program for operating a portable memory device on the host machine **(step 320 of Figure 3, where the peripheral device [corresponding to a portable memory device] uploads a driver**

to the host, also Column 2 Lines 30-32 and Column 4 Lines 38-65, and the driver is for operating the host, Column 1 Lines 38-43); and

install program data for installing the driver program data **(step 320 of Figure 3, where the driver is installed, thus install program data is inherently present to initiate the installation)**;

wherein the install program data automatically installs the driver program data on the host machine in response to connecting the portable memory to the host machine **(the process in Figure 3 and described on Column 4 Line 15 to Column 5 Line 15 requires no user intervention and begins upon connection of the device [Column 4 Lines 15-16], and the process is referred to as 'automatic' in the abstract, thus the driver program data is automatically installed)**.

It would have been obvious to a person having ordinary skill in the art at the time the invention was made to which the subject matter pertains to have implemented the automatic driver installation of Goodman in the memory device of Boyle and Ehara because this avoids the need for external media in installing devices (Column 2 Lines 8-18 in Goodman).

Further, the above references do not teach at least one of the image and audio data to be reproduced is selected via the host machine by a user, the selected data being not changed by a user.

Parulski teaches a media device holding pictures, which, when connected to a host computer, a user can select from the host device which categories of pictures the user wishes to transfer from the camera to the host **(left half of Figure 4 and Column**

6 Line 60 to Column 7 Line 7). It would have been obvious to person having ordinary skill in the art at the time the invention was made to which the subject matter pertains to have allowed a user to select images via the host machine to determine which images are transferred to the host system (as in Parulski) in the device of Boyle, Ehara, and Goodman, since the user may not want all the images on the portable device in the host device.

Regarding Claim 13, Ehara teaches a data processing system comprising:

a host machine **(personal computer of Figure 4)** having an interface capable of data input/output **(the host computer can automatically read files stored on the memory stick, thus the portable memory device is capable of data input/output)**, and

a portable memory device **(memory stick of Figure 4)** comprising:

a terminal capable of being connected to said interface **(the terminal corresponding to the part of the memory stick that "is inserted into a memory slot", Paragraph 0066)**, and

a storage element for storing at least one of image data and audio data **(image data on the memory stick of Figure 4)**,

reproduction program data for said host machine to reproduce at least one of said image data and audio data **("upload program stored in the memory stick" which reproduces the data onto the personal computer, Paragraph 0078)**, and execution program data for said host machine to execute said reproduction program

using said reproduction program data **(since the operating system activates the upload program, there is inherently execution program data to execute the reproduction program)** in response to a detection signal indicating that said host machine detects a connection of said terminal to said interface **(step S1 of Figure 3)**; and install program data for installing the reproduction program data and the execution program data, wherein, when the host machine does not store the reproduction program data and the execution program data, the install program data automatically installs the reproduction program data and the execution program data **(since the operating system runs the reproduction program on the memory stick, Paragraph 0078, the reproduction and execution program data are not stored on the host machine and instructions for installing the reproduction program and execution data are inherently present in the storage element in order to install and run the program on the host)** on the host machine in response to connection the portable memory device to the host machine **(Figure 3 and paragraphs 0073 - 0081)**.

However, Ehara does not explicitly teach a writing program to write at least one of said image data and audio data from said host machine to said storage element in response to a detection signal indicating that said host machine detects a connection of said terminal to said interface.

Boyle teaches a writing program to write at least one of image data and audio data from a host machine to a storage element in response to a detection signal that a host machine detects a connection of said terminal to said interface **(see the**

description of the write program that uploads data from a personal computer 110 to the handheld electronic device 124, paragraph 0036).

It would have been obvious to a person having ordinary skill in the art at the time the invention was made to which the subject matter pertains to have implemented the writing program of Boyle in the device of Ehara in order to transfer images from a host device to a portable memory device, thereby allowing one to easily transfer images to other host devices utilizing the portable memory device.

Further, neither Ehara nor Boyle explicitly teaches storing or installing driver program data on the host machine. Goodman teaches a driver program for operating a portable memory device on the host machine **(step 320 of Figure 3, where the peripheral device [corresponding to a portable memory device] uploads a driver to the host, also Column 2 Lines 30-32 and Column 4 Lines 38-65, and the driver is for operating the host, Column 1 Lines 38-43)**; and

install program data for installing the driver program data **(step 320 of Figure 3, where the driver is installed, thus install program data is inherently present to initiate the installation)**;

wherein the install program data automatically installs the driver program data on the host machine in response to connecting the portable memory to the host machine **(the process in Figure 3 and described on Column 4 Line 15 to Column 5 Line 15 requires no user intervention and begins upon connection of the device [Column 4 Lines 15-16], and the process is referred to as 'automatic' in the abstract, thus the driver program data is automatically installed)**.

It would have been obvious to a person having ordinary skill in the art at the time the invention was made to which the subject matter pertains to have implemented the automatic driver installation of Goodman in the memory device of Boyle and Ehara because this avoids the need for external media in installing devices (Column 2 Lines 8-18 in Goodman).

Further, the above references do not teach at least one of the image and audio data to be reproduced is selected via the host machine by a user, the selected data being not changed by a user.

Parulski teaches a media device holding pictures, which, when connected to a host computer, a user can select from the host device which categories of pictures the user wishes to transfer from the camera to the host **(left half of Figure 4 and Column 6 Line 60 to Column 7 Line 7)**. It would have been obvious to person having ordinary skill in the art at the time the invention was made to which the subject matter pertains to have allowed a user to select images via the host machine to determine which images are transferred to the host system (as in Parulski) in the device of Boyle, Ehara, and Goodman, since the user may not want all the images on the portable device in the host device.

Claim 12 is rejected under 35 U.S.C. 103(a) as being unpatentable over Boyle, Ehara, Goodman, and Parulski in view of AppleCare Document: 122014.

Regarding Claim 12, Boyle, Ehara, Goodman, and Parulski teach all limitations of Claim 11 as described above, wherein the program has code comprising

an outputting step of outputting at least one of said image data and audio data to said portable memory device (see description of outputting data from a personal computer to the handheld electronic device, paragraph 0036 in Boyle).

However, while Boyle mentions that images and 'other such data' (paragraph 0008) may be transferred across to the portable media device (also see paragraph 0036 where image data is downloaded to the portable device from a host device), he does not give an example of what this 'other data' may be. Apple's iPod, however, enables users to download software from Apple that is transferred from a host machine to the iPod portable memory device automatically once it is connected to the host machine (see first paragraph of AppleCare Document: 122014).

It would have been obvious at the time the invention was made to a person having ordinary skill in the art to which the subject matter pertains to add a controlling step of controlling to output said image reproduction and execution data onto the host computer and to transfer this program to the handheld device during the outputting step just as the iPod Updater has a controlling step of controlling to output audio reproduction and execution data. The motivation for this is that it keeps software programs flexible, and any minor bug in a program on a handheld device would be able to fixed by uploading to the handheld device a new version of software from the host (see AppleCare Document: 122014 for a list of bug fixes in the iPod software, for example).

Claim 14 is rejected under 35 U.S.C. 103(a) as being unpatentable over Boyle, Ehara, Goodman, and Parulski in view of Kahn (US 2004/0004737).

Regarding Claim 14, Boyle, Ehara, Goodman, and Parulski teach all limitations of Claim 13 as addressed above. Ehara teaches said system further comprising an external apparatus connected to said host machine via a network (HTTP server 30 of Figure 2), but does not explain what data could be transferred over the network. Kahn teaches a network over which images are shared, including an external apparatus (image server 331-333 in Kahn). It would have been obvious at the time the invention was made to a person having ordinary skill in the art to which the subject matter pertains that Kahn's network could be the network in Boyle. In this combination, when a device (such as handheld device 110) is connected to a host machine (such as 120 in Boyle) a program (such as the program specified in Kahn that begins at 522 in Figure 5, also see paragraph 0082) is run that uploads images to the external apparatus. The motivation for this comes from Kahn, who states that his network provides the benefits of automatic organization and easy sharing among friends (paragraph 0089 in Kahn).

Claim 15 is rejected under 35 U.S.C. 103(a) as being unpatentable over Boyle, Ehara, Goodman, and Parulski in view of Sesek (US 2003/0076365).

Regarding Claim 15, Boyle, Ehara, Goodman, and Parulski teach all limitations of Claim 9 as addressed above. Boyle teaches a memory device of a portable type that can store images as well as programs for exchanging these images, but does not teach displaying these images as icons or as a reduced image of a file. However, Sesek

teaches a technique that displays reduced images, or "thumbnails" of each image that can be displayed by a host machine (see paragraphs 0008-0011 in Sesek). It would have been obvious at the time the invention was made to a person having ordinary skill in the art to which the subject matter pertains to integrate this display system into the writing program that writes selected files to a portable memory device (such as that described in paragraph 0036 of Boyle). Motivation for this comes from Sesek, who states that thumbnails 'are useful for indicating the contents of a page or image' (paragraph 0007 in Sesek) and also that they allow the user 'to easily select pages or images for viewing' (paragraph 0006 in Sesek). Thus, by integrating Sesek's technique into the write program, additional benefits are obtained.

ARGUMENTS CONCERNING PRIOR ART REJECTIONS

Applicant's argument regarding claims 9, 11, and 13 that neither Boyle, Parulski, nor Goodman would disclose or render predictable "when the host machine does not store the reproduction program data, the execution program data and the driver program data, the install program data automatically installs the reproduction program data, the execution program data and the driver program data on the host machine in response to connecting the portable memory device to the host machine" has been considered but is moot in view of the new grounds of rejection.

CLOSING COMMENTS

Conclusion

STATUS OF CLAIMS IN THE APPLICATION

The following is a summary of the treatment and status of all claims in the application as recommended by **M.P.E.P. ' 707.07(i)**:

CLAIMS REJECTED IN THE APPLICATION

Per the instant office action, claims 9-15 have received a first action on the merits and are subject of a first action non-final.

DIRECTION OF FUTURE CORRESPONDENCES

Any inquiry concerning this communication or earlier communications from the examiner should be directed to M. Anthony Giardino whose telephone number is (571) 270-3565 and can normally be reached on Monday - Thursday 7:30am – 5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. Sanjiv Shah can be reached on (571) 272-4098. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

M.A. Giardino

/M.G./

Patent Examiner
Art Unit 2185

August 2, 2010

/Stephen Elmore/
Primary Examiner, Art Unit 2185